

# PATENT COOPERATION TREATY

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From the  
INTERNATIONAL SEARCHING AUTHORITY

REC'D 20 MAY 2003
PCT WIPO PCT

To:

see form PCT/ISA/220

28/f

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

### FOR FURTHER ACTION

See paragraph 2 below

International application No.  
PCT/EP2005/000501

International filing date (day/month/year)  
19.01.2005

Priority date (day/month/year)  
19.01.2004

International Patent Classification (IPC) or both national classification and IPC  
C07D403/04

Applicant  
NOVARTIS AG

### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

### 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2005/000501

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**Box No. I Basis of the opinion**

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1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
  - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:
    - ☐ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material:
    - ☐ in written format
    - ☐ in computer readable form
  - c. time of filing/furnishing:
    - ☐ contained in the international application as filed.
    - ☐ filed together with the international application in computer readable form.
    - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

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**Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
- ☒ claims Nos. 10 (w.r.t. industrial applicability)

because:

- ☒ the said international application, or the said claims Nos. 10 relate to the following subject matter which does not require an international preliminary examination (*specify*):  
**see separate sheet**
- ☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):
- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☐ no international search report has been established for the whole application or for said claims Nos.
- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:
  - the written form ☐ has not been furnished
  - ☐ does not comply with the standard
  - the computer readable form ☐ has not been furnished
  - ☐ does not comply with the standard
- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.
- ☐ See separate sheet for further details

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**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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**1. Statement**

Novelty (N)	Yes: Claims	1-10
	No: Claims	
Inventive step (IS)	Yes: Claims	1-10
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-9
	No: Claims	

**2. Citations and explanations**

**see separate sheet**

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**Box No. VII Certain defects in the international application**

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The following defects in the form or contents of the international application have been noted:

**see separate sheet**

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**Box No. VIII Certain observations on the international application**

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The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

**see separate sheet**

**Re Item III**

**Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

Claims 10 relates to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iv) PCT. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of this claim (Article 34(4)(a)(i) PCT).

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

D1: WO 02/38561 A (NOVARTIS AG; NOVARTIS-ERFINDUNGEN  
VERWALTUNGSGESELLSCHAFT M.B.H; ALBER) 16 May 2002 (2002-05-16)

**Novelty**

The document D1 discloses indolylmaleimide derivatives as CDK inhibitors which structurally differ from the compounds of claim 1 in that the naphthyl substituent is permanently substituted at position 6 (see page 1, title; page 1, Formula I; page 40, paragraph 2; page 41, last paragraph - page 42, first paragraph; Examples 28-52).

In view of this prior art, novelty has to be acknowledged for the subject-matter of the independent claims 1 and 4-10 and the dependent claims 2 and 3.

**Inventive step**

The distinguishing feature between the novel subject-matter and D1 is the fact that the naphthyl group is permanently substituted at position 6.

In the absence of any evidence for an unexpected technical effect linked to this feature, the objective problem underlying the novel subject-matter can merely be seen as the provision of further compounds suitable as CDK inhibitors.

The claimed solution to this very general problem was the modification of the naphthyl derivatives already known from D1 by "shifting" the permanent substituent from position 3 towards position 6.

However, since this solution was not derivable from D1, the presence of inventive step has to be acknowledged for the novel subject-matter, even in the absence of a technical effect.

**Industrial applicability**

There is no doubt that the subject-matter of the present claims 1-9 is industrially applicable.

However, for the assessment of the present claim 10 on the question whether it is industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.

**Re Item VII**

**Certain defects in the international application**

Apparently, clerical error appears on page 3 of the description: it should have read WO03/82858 instead of WO03/08259.

**Re Item VIII**

**Certain observations on the international application**

The breadth of a claim should be such that it could be expected that all possibilities comprised would actually solve the problem underlying the application. Consequently, a claim should only include such possibilities (and their reasonable generalisations) which have been made credible in the specification. It appears thus that open definitions such as "aryl" and "heterocyclic residue" (see claims 1 and 2) go far beyond what has actually been verified in the worked Examples on file.

Moreover, a person skilled in the art cannot assume that all those possibilities which are presently comprised would be suitable in the sense of solving the present problem.